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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,026	02/15/2001	Yoshihide Iteya	57139-5045	3020
24574	7590	05/27/2005	EXAMINER	
JEFFER, MANGELS, BUTLER & MARMARO, LLP 1900 AVENUE OF THE STARS, 7TH FLOOR LOS ANGELES, CA 90067			SMITH, JULIE KNECHT	
			ART UNIT	PAPER NUMBER
			3682	

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/785,026	<b>Applicant(s)</b> ITEYA, YOSHIHIDE	
	<b>Examiner</b> Julie K Smith	<b>Art Unit</b> 3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Further, the applicant claims that the push button (40) is moveable within the recess (46); however, the specification does not provide support for how the button is moveable within the recess and it appears from the drawings that the button is only moveable within the recess for assembly/disassembly.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 and 3-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicant claims that the button is moveable within the recess; however, the scope of the claim is unclear, as the movement of the button within the recess is not clearly defined. The button could be moveable only during assembly/disassembly, or during operation of the button to perform a function.

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3-6, 9-11, 13-17, 20, 23-25 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Abe (6,073,730). Abe discloses a bicycle control device for holding a computer switch having an operation control device, the device comprising a shift control device integrated with a brake control device (see fig. 11), a casing (38) encompassing the brake/shift control device wherein the casing defines a recess therein, the recess having a bottom wall (31) and side wall (38) wherein the recess has a shape conforming to the outer periphery of the operation control button (54), said control button is connected to the bicycle control device and moveable within the recess. An elastic cover (35a) partially surrounds the control switch and is press fitted into the recess and a retaining ring (37) is fastened to the casing. Abe further discloses a cable mounting recess (84) therein in communication with the switch mounting recess, wherein the cable mounting recess extends from the switch mounting recess in the direction of the cycle computer, and wherein a portion of the connecting cable (10) is mounted in the cable mounting recess.

Regarding claims 20 and 23-25, although the reference combination is silent concerning the particular method set forth in claims 20, and 23-25, the manufacture of the apparatus, as set forth above, would obviously lead to the method steps recited in the claims.

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*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 7 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abe, as applied to claims 1, 3-6, 9-11, 13-17, 20, 23-25 and 27 above, and further in view of Seimitsu (JP 20026893).

Regarding claim 7, Abe discloses a bicycle control device, as claimed, but does not disclose the control switch being attached in the switch mounting recess by an adhesive. However, Seimitsu teaches using an adhesive to attach a portable clock to a fixed base.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to attach the control switch to the mounting recess using an adhesive so as to provide a secure connection between the switch and recess. Moreover, using an adhesive to attach one member to another is old and well known in the art and would have been obvious to one of ordinary skill in the art at the time the invention was made.

Regarding claim 21, although the reference combination is silent concerning the particular method set forth in claim 21, the manufacture of the apparatus, as set forth in the reference combination above, would obviously lead to the method steps recited in the claims.

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8. Claims 8 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abe as applied to claims 1, 3-6, 9-11, 13-17, 20, 23-25 and 27 above, and further in view of Miyoshi et al. (JP 04048521).

Regarding claim 8, Abe discloses a control device but does not disclose the switch mounting recess receiving an attachment arm, as claimed. However, Miyoshi et al. teaches a switch mounting recess defining a hole (9a,b) therein, the control switch (12) having an attachment arm (13) made of an elastic material, wherein the attachment arm is press-fitted into the hole of the switch mounting recess.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the control device of Abe with the teachings of Miyoshi et al. to provide the switch with a press-fitted mounting so as to provide a more secure and stable form of attachment for the control device switch.

Regarding claim 22, although the reference combination is silent concerning the particular method set forth in claim 22, the manufacture of the apparatus, as set forth in the reference combination above, would obviously lead to the method steps recited in the claims.

9. Claims 12 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abe as applied to claims 1, 3-6, 9-11, 13-17, 20, 23-25 and 27 above, and further in view of Hill et al. (5,745,438). Abe discloses a bicycle control device having a retention ring, but does not disclose a threadingly engaged retention ring. However, Hill et al. teaches a threaded retention ring used to secure a member (17) within a recess (32).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Abe with the teachings of Hill et al. so as to provide a secure method of retaining the control switch within the recess that could withstand the rough conditions to which a bicycle might be exposed.

Regarding claim 26, although the reference combination is silent concerning the particular method set forth in claim 26, the manufacture of the apparatus, as set forth in the reference combination above, would obviously lead to the method steps recited in the claims.

10. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abe in view of Chou (5,370,412). Abe discloses a handlebar assembly comprising a handlebar having an end, a hand grip, a control device (see fig. 1) attached to the handlebar proximal the hand grip such that the rider's hand can reach the control device while remaining on the hand grip, the control device having a top surface defining a switch mounting recess, and a control device mounted in the recess. Abe does not disclose a computer assembly, as claimed. However, Chou discloses a cycle computer attached to a handlebar, separate from a control device with a connecting cable (36) electrically connecting a control switch to the cycle computer (see fig. 1).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a cycle computer attached to a handle bar connected by a cable to a separate control switch so as to allow the computer screen to be visible to the rider while keeping the controls close to the hand grip so that the rider does not have to move his hand to reach the controls.

***Response to Arguments***

11. Applicant's arguments filed 4/8/05 have been fully considered but they are not persuasive.

Regarding applicant's argument over the 35 USC 112 1<sup>st</sup> rejection, although the applicant states that the switch is moveable within the recess, Figures 3-7 show a button that is not operably moveable within the recess. The button appears to be fixed in the recess by several means, including adhesive, a retainer ring, and press fit. It appears that the applicant's button only moves into the recess during assembly/disassembly, not during operation.

In response to applicant's argument that Seimitsu is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Seimitsu was concerned with the attachment of an electronic device to a base, similar to the problem that the applicant was concerned with in attaching the control button within a recess.

In response to applicant's argument that the examiner's conclusion of obviousness regarding the Miyoshi reference is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Further, the applicant argues that



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the spring of Miyoshi is not an elastic attachment arm. However, the spring, which is inherently elastic, is used to attach the button (12) to a base and can, therefore, be considered an elastic attachment arm.

In response to applicant's argument that Hill is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Hill teaches a method of securing a device within a housing, which is pertinent to the problem with which the applicant was concerned with in securing the control button within the recess.

### *Conclusion*

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Smith whose telephone number is 571.272.7112. The examiner can normally be reached on Monday-Friday, 8-5:30, (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Bucci can be reached on 571.272.7099. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jks

Jks

May 17, 2005

  
DAVID FENSTERMACHER  
PRIMARY EXAMINER 5/26/05